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EXAMINER

OSELE, MARK A

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1734

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/759,993
Filing Date: January 12, 2001
Appellant(s): ANDERSON ET AL.

MAILED

APR 10 2006

GROUP 1700

Kevin Raasch
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

Pursuant to the remand under 37 CFR 41.50(a)(1) by the Board of Patent Appeals and Interferences on September 30, 2005 **for further consideration of a rejection**, a supplemental Examiner's Answer under 37 CFR 41.50(a)(2) is set forth below:

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct. In addition, appellants group the claims into through groups: Group I, claims 1, 5, 8-10, 12, 18, 21, 22, and 25; Group II, claims 1, 5, 8-10, 12, 18, 21, 22, and 25; and Group III, claims 23-24. Appellants' brief includes a statement grouping the claims and

Art Unit: 1734

provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8) why the claims of each group stand or fall together.

NEW GROUND(S) OF REJECTION: Claim 23 rejected under 35 U.S.C. 103(a) as being unpatentable over French Patent Publication 2643487 in view of Stadtmueller.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,891,298	KURODA et al.	4-1999
FR 2,643,487	APOLLONIO et al.	8-1990
5,891,297	Stadtmueller	4-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 4, 8-13, 17, 21-22, and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by French Patent Publication 2643487 (Apollonio et al.). Regarding claims 1, 12, and 22, Apollonio et al. shows a film removal method and apparatus comprising applying tension over the width of the adhesive film by adhering the film to a take up roll, 24, transferring the tension onto the substrate through a compressive roller, 34, such that as the removal apparatus is moved from a first end of the film to the opposite

Art Unit: 1734

end the release line and compressive roller are also moved. In the method shown, the compressive roller moves at a distance behind the release line (Fig. 3; English translation, page 5, paragraph 1).

Regarding claims 4 and 17, the compressive roller moves at a distance behind the release line (Fig. 3; English translation, page 5, paragraph 1).

Regarding claim 8, the compressive force is applied to the substrate by a roll, 34.

Regarding claim 9, the tension is applied by attaching the first end of the adhesive film to a winding roll, 24, and winding the adhesive film thereon.

Regarding claim 10, the compressive force is applied by a support roll, 24, and the support roll, 34, and winding roll, 24 are a fixed distance apart.

Regarding claims 11, 21 and 25, Apollonio et al. further teaches adding a heater to the method (page 5, paragraph 2).

Regarding claim 13, Apollonio et al. shows the invention to be used to apply and remove poster sections, which would be considered to be large-scale films.

Claims 1, 5, 8-10, 12, 18, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Kuroda et al. Regarding claims 1, 12, and 22, Kuroda et al. shows a film removal method and apparatus comprising applying tension over the width of the adhesive film by adhering the film to a take up roll, 19, transferring the tension onto the substrate through a compressive roller, 8, (which also functions to apply tape) such that as the removal apparatus is moved from a first end of the film to the opposite end the release line (at roller 6) and compressive roller are also moved.

Regarding claims 5 and 18, in the method shown, the compressive roller, 8, moves at a distance ahead of the release line tangential to roller 6 (See Fig. 8).

Regarding claim 8, the compressive force is applied to the substrate by a roll, 8.

Regarding claim 9, the tension is applied by attaching the first end of the adhesive film to a winding roll, 19, and winding the adhesive film thereon.

Regarding claim 10, the compressive force is applied by a support roll, 8, and the support roll, 8, and winding roll, 19 are a fixed distance apart (See Fig. 13).

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over French Patent Publication 2643487 (Apollonio et al.). Apollonio et al. shows the claimed features except for a variable speed motor. Variable speed motors are conventional because they allow for operator control of the processing speed, especially at start up or nearing completion. It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the claimed variable speed motor to the apparatus of Apollonio et al. to increase operator control.

NEW GROUND(S) OF REJECTION

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over French Patent Publication 2643487 (Apollonio et al.) in view of Stadtmueller. Apollonio et al. shows the claimed features except for a conformable roller. Stadtmueller shows a peeling apparatus and teaches that pressing rollers are conformable to reduce the risk of damage to a substrate (column 2, line 62 to column 3, line 8). It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the

Art Unit: 1734

claimed conformable roller to the apparatus of Apollonio et al. to reduce the risk of damage.

(10) Response to Argument

Appellants argue that the examiner's assertion in the final rejection that the structures of Apollonio et al. and Kuroda et al were parallel to the structure of the instant invention have not been shown. As such, appellants argue, inherency cannot be shown if parallel structures and methods have not been shown. Countering Appellants' argument is the following detailed analysis of each instantly claimed element with corresponding parallel elements of the inventions of both Apollonio et al. and Kuroda et al. This analysis proves that the instantly claimed method and apparatus are inherently taught by the disclosures of both Apollonio et al. and Kuroda et al.

Inspection of Figs. 1 and 3 of Apollonio et al. shows analogous structures to Fig. 4 of the instant invention. In the invention of Apollonio et al., film, 32, on surface of structure, 20, is wound on reel, 24, which is kept a distance from the surface. In the instant invention, film, 112, is peeled from surface, 114, by being wound on reel, 120, which is kept a distance from the surface. Framework of Apollonio et al. pivotally connects the winding reel, 24, with rollers, 34, which ride along the surface of structure, 20. Framework, 130, of the instant invention pivotally connects the winding reel, 120, with roller, 140, which rides along the surface, 114, of the structure. The tension of film, 32, winding on spaced apart reel, 24, will pivot the framework of Apollonio et al. pressing the rollers, 34, against the surface of the structure thereby transferring the

Art Unit: 1734

tension from the film onto the structure itself just as the tension of film, 112, winding on spaced apart reel, 120, will pivot the framework of the instant invention pressing the roller, 140, against the surface of the structure thereby transferring the tension from the film onto the structure itself in the form of a compressive force.

Inspection of Fig. 8 of Kuroda et al. shows analogous structures to Fig. 4 of the instant invention. In the invention of Kuroda et al., film, 3, on surface of structure, W, is wound on reel, 18, via peeling roller, 6, which is kept a distance from the surface. In the instant invention, film, 112, is peeled from surface, 114, by being wound on reel, 120, which is kept a distance from the surface. Framework of Kuroda et al. pivotally connects the winding reel, 18, with rollers, 8, which rides along the surface of structure, W. Framework, 130, of the instant invention pivotally connects the winding reel, 120, with roller, 140, which rides along the surface, 114, of the structure. The tension of film, 3, winding on spaced apart reel, 18, will pivot the framework of Kuroda et al. pressing the rollers, 8, against the surface of the structure thereby transferring the tension from the film onto the structure itself just as the tension of film, 112, winding on spaced apart reel, 120, will pivot the framework of the instant invention pressing the roller, 140, against the surface of the structure thereby transferring the tension from the film onto the structure itself in the form of a compressive force.

Appellants further argue that they provided possible explanations of tension force dispersion in their after final amendment and arguments (Paper # 15). A distillation of their arguments is: The transfer of tension in the Apollonio et al. reference onto the

Art Unit: 1734

substrate cannot occur because the carriage moves along a rigid pole and the tension forces would be directed onto the rigid pole; The tension forces of Kuroda et al. could be directed to the framework supporting the rollers.

As noted above, the inventions of Apollonio et al. and Kuroda et al. have parallel structures to the apparatus of the instant invention. Appellants, in their specification (Page 7, lines 13-19) state: "*Much of the tension force applied to the adhesive film...can then be transferred back to the substrate in the form of a compressive force.....the structures needed to support frame 130 relative to the substrate 114 may be reduced by balancing the tension force...with a compressive force...on substrate...*" (emphasis added). Appellants do not describe what the structures to support the frame are. They may be a rigid pole such as that of Apollonio et al. or they may be framework supporting the rollers such as that of Kuroda et al. Regardless, it is clear that some of the tension forces are transferred back onto the substrate while the rest of the tension forces are transferred elsewhere. By virtue of their parallel structures with the instant invention, it stands to reason that even if some of the tension forces of Apollonio et al. are transferred to the rigid pole and some of the forces of Kuroda et al. are transferred to the framework, the rest of the forces would still be transferred back onto the substrate through the compressive force.

In the reply brief, the appellants have argued that there is no evidence that the peeling devices of either Apollonio et al. or Kuroda et al. would pivot. The examiner's assertion that these devices would pivot is based upon an analysis of the kinetics of the

Art Unit: 1734

systems. In both of the prior art devices the tape being peeled is taut and under tension. This tension would pull the wind up roller toward the substrate to the extent of the play available in the axle of the wind up roller or the framework holding the wind up roller. The above statements are not meant to suggest that the entire framework pivots across a broad arc, but rather the pivoting occurs to the extent possible within its moorings.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

The appellant must within **TWO MONTHS** from the date of the supplemental examiner's answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the rejection for which the Board has remanded the proceeding:

(1) **Reopen prosecution.** Request that prosecution be reopened before the examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit, or other evidence. Any amendment, affidavit, or other evidence must be relevant to the issues set forth in the remand or raised in the supplemental examiner's answer. Any request that prosecution be reopened will be treated as a request to withdraw the appeal. See 37 CFR 41.50(a)(2)(i).

Art Unit: 1734

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. If such a reply brief is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened under 37 CFR 41.50(a)(2)(i). See 37 CFR 41.50(a)(2)(ii).

Extensions of time under 37 CFR 1.136(a) are not applicable to the **TWO MONTH** time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

A Technology Center Director or designee has approved this supplemental examiner's answer by signing below:

Respectfully submitted,



Mark A. Osele

April 2, 2006

Conferees

Christopher A. Fiorilla



Steven Griffin



GREGORY MILLS
QUALITY ASSURANCE SPECIALIST